

**REMARKS/ARGUMENTS**

The Applicants' representative has carefully reviewed the Examiner's Office Action of February 7, 2006, in which the Examiner essentially restated his obviousness rejection from two earlier office actions of March 25, 2005 and October 20, 2005. Specifically, the Examiner rejected claims 1-13 and 15-30 under 35 U.S.C. 103(a) as being obvious over some combination of Shoji (USPN 5,378,553), Grisamore (USPN 6,132,055), Petzl (USPN 6,499,859), and Sutherland (USPN 5,641,220).

With respect to the Examiner's restriction, the Applicants hereby withdraw the non-elected claims.

With respect to the Examiner's objections to the drawings, the Applicants submit that the drawings show every feature of the invention specified in the claims, namely the pivot axis, the first side, the second side, etc. Nevertheless, the Applicant amends claim 27 and, with reference to Figure 2 and especially Figure 3, the Applicants submit that the features of the amended claim are shown. Specifically, Figure 3 shows a lower member, a hinge, and a handle, the hinge securing the upper member to the lower member such that the upper member rotates about a horizontal axis (see arrows in Figure 3 and page 10, lines 6-7: "The upper member or cover 18 is secured to the grill 10 by a hinge"), the upper member covering the lower member in a closed position, the upper member and the lower member defining a cooking chamber, the cooking chamber having a cooking grid, the handle being attached to the upper member and being generally parallel to the horizontal axis.

With respect to the Examiners obviousness rejections, the Applicants incorporate by reference their arguments as filed in two earlier amendments of June 10, 2005 and January 20, 2005 – namely that the cited bicycle art is non-analogous, that there is no motivation to combine the bicycle art with the grill art, and that the failure of others suggests that the claimed invention is non-obvious - as supplemented below:

Bicycle art is non-analogous:

The Applicants respectfully reiterate and expand upon their disagreement with the Examiner's stance that the bicycle art cited by the Examiner, including Shoji, is analogous art. In response to the Applicant's previously submitted arguments, the Examiner cites *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992), for the rule that a reference must either be in the field of applicant's endeavor or, if not, then must be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

Before responding to the Examiner's specific arguments that the bicycle art is analogous, the Applicants believe a brief discussion of *In re Oetiker* is appropriate. The patent application-at-issue in that case dealt with a "hook" for a hose clamp. The Examiner rejected the claims on the basis of a prior art reference which disclosed a hook used for garments, arguing that the prior art was analogous art because it was related to a hooking problem, just like Oetiker's invention. The Federal Circuit ultimately rejected the Examiner's argument and "reminded . . . the PTO that it is necessary to consider 'the reality of the circumstances' – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a

solution to the problem facing the inventor.” *In re Oetiker*, 977 F.2d at 1447 (internal citations omitted). The Federal Circuit ultimately held that a person of ordinary skill in the art, seeking to solve a problem of fastening a hose clamp, would not reasonably be expected or motivated to look to fasteners for garments. *Id.* The Applicants likewise argue that a person of ordinary skill in the art, seeking to solve a problem of illuminating a grill cooking surface, would not reasonably be expected or motivated to look to illumination devices for bicycles.

Turning now to the Examiner’s specific argument, the Examiner purports that the bicycle art is analogous – and that the *In re Oetiker* rule, discussed above, is met – because Shoji and Grisamore are both classified under class 362, general illumination. The Applicants respectfully disagree with the Examiner and submit that the fact that the USPTO assigned Shoji and Grisamore to the same class is not enough to show that Shoji is analogous art. After all, the Federal Circuit has taken the position that, “as far as the matter of analogous prior art is concerned, evidence of classification of prior art . . . ‘is inherently weak’ . . . because considerations in forming a classification system differ from those relating to a person of ordinary skill seeking a solution for a particular problem.”” *In re Huene*, 2000 U.S. App. LEXIS 19978, \*14 (Fed. Cir. 2000) (citing *In re Mlot-Fijalkowski*, 676 F.2d 666, 670 (CCPA 1982)) (emphasis added). While the CCPA has found that similar classification is “*some evidence of analogy, [the CCPA considered] the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight.*” *In re Mlot-Fijalkowski*, 676 F.2d at 670 (italics in original, underlining added).

As emphasized in the Applicants earlier amendments, (1) barbecue grills are substantially different in structure and function than bicycles; and (2) the barbecue grill handle disclosed in Grisamore (and in the present invention) is substantially different in structure and function than the bicycle handle disclosed in Shoji. To begin with, bicycle handles are attached to bicycles at a pivot point, wherein the axis about which the bicycle handle rotates is *perpendicular* to the longitudinal axis of the handle. Notably, the pivot axis of a bicycle handle typically intersects the longitudinal axis of the bicycle handle, or is close thereby. Bicycle handles are used to steer a bicycle wherein the handle is rotated in a plane generally parallel to ground. Because bicycle handles are rigidly fixed to the front wheel of a bicycle, the direction of travel of the bike (and consequently the desired direction of illumination) is fixed with respect to the bicycle handle.

Conversely, a barbecue grill handle is attached to the front of an upper member (or lid) of the grill which, in turn is hingedly attached at the rear to the lower member of the grill. As such, the grill handle rotates about an axis which is generally *parallel* to the longitudinal axis of the handle and the rotational axis of a barbecue grill lid is significantly offset from the handle. With regards to function, barbecue grill handles are not typically used to steer a direction of travel of a barbecue grill, but are instead used to open and close a barbecue grill lid.

Notably, barbecue grill handles rotate about their longitudinal axis when opening and closing the barbecue grill, due to the offset rotational axis. Consequently, whereas the desired direction of illumination for a bicycle is fixed relative to the bicycle handle, the desired direction of illumination (the grill cooking surface) is not fixed relative to the barbecue handle. For this reason, and for the reasons provided above, the problems associated with directing a light in an

appropriate direction during use of a bicycle are substantially different from the problems associated with directing a light during use of a barbecue grill.

There is no motivation to combine Shoji with Grisamore:

Even if the Examiner is correct that the bicycle art is analogous prior art, the Applicants respectfully submit that the Examiner has not met his burden of providing a prima facie case of obviousness. Indeed, the Applicants continue to strongly disagree with the Examiner that Grisamore contains a motivation to combine the bicycle light of Shoji with the handle of a barbecue grill, as asserted on page 17 of the office action. The Applicants do not disagree with the Examiner that Grisamore teaches a barbecue light where a grill handle is a light-containing tube. What the Applicants disagree with is that Grisamore would motivate a person of ordinary skill in the art to attach a light fixture to the outside surface of a grill handle or that Shoji would motivate a person of ordinary skill in the art to attach the headlamp to a barbecue grill handle. In fact, as discussed in the Applicant's previously amendment, the Applicants believe that Grisamore actually teaches away from attaching light fixtures to grill surfaces. The Federal Circuit has said that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Referring specifically to col. 1, lines 10-20, Grisamore explains that prior art, clamp-on light fixtures for barbecue grills that are designed to attach to nearby trays or other physical objects are cumbersome, awkward, and expensive and cast shadows on the cooking surface so as

to obscure the desired view of food items being cooked. For this reason, the Applicant respectfully asserts that Grisamore teaches away from the invention because it discourages a person of ordinary skill in the art from "attaching" a device such as that disclosed in Shoji to a grill handle. Thus, Grisamore cannot contain a motivation to combine Shoji with a barbecue grill handle to arrive at the present invention.

In response to the Examiner's citation of *In re Keller* for the argument that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references, the Applicants respectfully assert that *In re Keller* is inapplicable to the instant case. *In re Keller* prohibits attacking references individually to show nonobviousness by objective evidence only after an Examiner has met his burden to put forth a prima facie case of obviousness; i.e. the Examiner must first show that it is appropriate to combine references. Here, the Applicants argue that the Examiner has not met this burden. Specifically, the Applicants argue that the Examiner has failed to meet his burden to show that there exists a motivation to combine Shoji and Grisamore. As such, it is appropriate to attack individual references. The Applicant's arguments that Shoji does not suggest using the headlamp on a barbecue grill handle and that Grisamore does not suggest attaching a light to the exterior of a handle are no different than the arguments made by the Federal Circuit in *In re Jones*:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. We see no such suggestion in Zorayan, which is directed to shampoo additives, nor in Wideman, which teaches that the amine used to make the claimed compound is a byproduct of the production of morpholine. Nor does the

broad disclosure of Richter fill the gap, for the reasons discussed above.

958 F.2d 347, 351 (Fed. Cir. 1992) (emphasis). Furthermore, because the Examiner specifically asserts that Grisamore contains the motivation to combine (see pages 16 and 17 of the office action – “there is a clear motivation that has been taught by the prior art reference Grisamore”), it is appropriate for the Applicant to attack Grisamore individually on the basis that Grisamore teaches away from attaching lights to external surfaces of a grill. *See In re Gurley*, 27 F.3d at 553 (“Gurley’s position appears to be that a reference that “teaches away” can not serve to create a prima facie case of obviousness. We agree that this is a useful general rule.”)

Even if the Examiner is correct that the Applicants may not attack references individually, the Applicants believe that Grisamore and Shoji, when combined, do not suggest the Applicants invention. Grisamore teaches a light-containing barbecue grill handle, whereas Shoji teaches an illumination device attached to a bicycle handle. While the Examiner seems to argue that a handle is a handle, the Applicants respectfully disagree and submit that a barbecue grill handle is not the same as a bicycle handle. Indeed, a barbecue grill handle is substantially different in structure and function than a bicycle handle (see the discussion above concerning the differences between the two). Consequently, even when Grisamore and Shoji are viewed in combination, there is no suggestion to attach a light fixture to a barbecue grill handle.

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Conclusion:

For the foregoing reasons, the Applicants believe that the claims are sufficiently distinguished from the prior art and are in condition for allowance.

**The Applicant believes that no fee is required for submission of this document. However, if Applicant's assumption is incorrect, you are hereby authorized to deduct the required amounts from our Deposit Account No. 02-0400 (Baker & McKenzie). *When identifying such a withdrawal, please use the Attorney Docket Number WEB-922-CIP.***

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Respectfully,

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